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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,154	06/16/2005	Atsushi Mae	450100-04851	2743
7590 Frommer Lawrence & Haug 745 Fifth Avenue New York, NY 10151			EXAMINER DANG, HUNG Q	
			ART UNIT 2621	PAPER NUMBER
			MAIL DATE 09/05/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,154

Applicant(s)

MAE, ATSUSHI

Examiner

Hung Q. Dang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 6 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 6 recites, "a program for recording method for a recording medium ..."

However, it appears that such would reasonably be interpreted by one of ordinary skill in the art as software, per se. This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Software does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

However, in contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035 (MPEP 2106.01.I).

Accordingly, the examiner suggests amending the claim to "a computer-readable medium encoded with a software program" or equivalent in order to make the claim statutory. Any amendment to the claim would be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isobe et al. (US 2003/0152369) and Kori et al. (US Patent 5,852,528).

Regarding claim 1, Isobe et al. disclose a recording apparatus ([0026]) capable of generating management data so that a system stream with an audio stream and a video stream multiplexed therein (AV stream in [0038]) can be managed as on recording unit from a recording start to a recording end corresponding to the recording start ([0016]; [0038]; [0043]) and also a plurality of recording units can be managed as another management unit ([0026]; [0028]), and also recording the system stream and management data ([0038]; [0043]; [0016]); characterized in that data for determination changing each time data corresponding to said recording unit is recorded in the recording medium is generated based on the management data and is recorded in the recording medium ([0016]; [0043]) to determine whether a plurality of recording units are

recorded on the same day in order to be placed under the same management unit (Isobe et al., [0026]; [0049]).

However, Isobe et al. do not disclose explicitly said data for determination is compared to the management data to determine a recording apparatus having the recording unit for data recorded last, and said management unit is switched according to a result of said determination.

Kori et al. disclose data for determination is compared to management data to determine a recording apparatus having the recording unit for data recorded last, and said management unit is switched according to a result of said determination (column 5, lines 22-46).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the comparison of the data for determination and the management data disclosed by Kori et al. as discussed above into the recording apparatus disclosed by Isobe et al. The incorporated feature is necessary because, without this feature, the recording apparatus disclosed by Isobe et al. could not manage the recording units properly, i.e., a chapter could not be determined to be associated with a corresponding chapter (Isobe et al., [0026]; [0049]).

Regarding claim 2, Kori et al. also disclose said data for determination is time information of said recording unit recorded last in the recording medium (column 5, lines 22-46).

Regarding claim 3, see the teachings of Isobe et al. and Kori et al. as discussed in claim 2 above. Furthermore, Isobe et al. also disclose said data for determination are

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used to determine whether or not a plurality of recording units are recorded on the same day ([0026]; [0049]). One of ordinary skill in the art would recognize that such a data for determination must comprise the recording start time and recording end time.

Regarding claim 4, Isobe et al. also disclose said data for determination is assigned to said management data and is recorded in said recording medium ([0016]; [0043]).

Claim 5 is rejected for the same reason as discussed in claim 1 above.

Claim 6 is rejected for the same reason as discussed in claim 1 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Q. Dang whose telephone number is (571)270-1116. The examiner can normally be reached on IFT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hung Q Dang/
Examiner, Art Unit 2621

/Thai Tran/
Supervisory Patent Examiner, Art Unit 2621